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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/624,508	04/05/96	DEL SOLDATO	105336,124

HALE AND DORR
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WASHINGTON DC 20004

12M2/0820

EXAMINER	
BUCKNOR, M	
ART UNIT	PAPER NUMBER
1202	4

DATE MAILED:

08/20/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/624508

Applicant(s)

Soldato

Examiner

Bucknum

Group Art Unit

1202

☒ Responsive to communication(s) filed on 4/5/96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 and 19-30 is/~~are~~ pending in the application.

Of the above, claim(s) 9-10 and 24-30 is/~~are~~ withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 and 19-23 is/~~are~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-2, 9-10 and 19-23, drawn to compound, composition and method of use, when compound is structural formula (XXX) and (XXXII), containing pyrrolo[1,2a]pyrrolyl and indolyl rings, respectively, classified in Class 548, subclass 491 and 516, respectively.

II. Claims 1-8 and 19-23, drawn to compound, composition and method of use, when compound is structural formula (XXXI) and (XXXIII), containing naphthyl and phenyl rings, classified in Class 558, subclass 482 and 483.

III. Claims 24-30, process of making, when compound is structural formula (XXX) through (XXXIII), containing pyrrolo[1,2a]pyrrolyl and indolyl rings classified in Class 548, subclass 491 and 516, respectively, and naphthyl or phenyl rings, classified in Class 558, subclass 482 and 483.

The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I through II are drawn to structurally dissimilar compounds. They are made and are used independently. They are independent.

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If, say, a compound of group I, were anticipated, applicants' would not acquiesce in rejection of group II thereover or vice-versa. They are (patentably) distinct.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case a carboxamide derivative of formula (VIA) could be reacted with a chloride derivative of formula (VII) to produce the carboxamide product by eliminating HCl.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for group I is not required for group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Baker on 8/8/96 a provisional election was made with traverse to prosecute the invention of Group II, claims 1-8 and 19-23. Affirmation of this election must be made by applicant in responding to this Office

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action. Claims 9-10 and 24-30 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-8 and 19-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Bron, et al., U.S.'694. Bron, et al. generically teach nitrate esters, with a structure incorporating an ester of an aromatic carboxylic acid, column 1, line 61-64, attached to an alkylene chain of 1-8 carbon atoms, which may be derivatized, column 2, line 21-28, and this group terminated as a nitrate ester, column 2, line 45-50.

The claims differ from the reference by reciting a specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art

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at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bucknum whose telephone number is (703) 308-4719.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1325.

Mukund J. Shah
MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1200